

## Remarks

### **I. Status of Claims**

Claims 1-8 and 18-24 have previously been canceled in the above-noted application. By this paper, claim 9 is amended and claims 26-35 are added. Claims 9-17 and 25-35 will be pending in the application upon entry of this amendment.

### **II. Request For Continued Examination**

This Amendment C is submitted with a Request for Continued Examination ("RCE") under 37 CFR 1.114 and the required RCE fee. The Patent Office issued a Notice of Allowance and Fee(s) Due ("Notice of Allowance") in the above application on September 8, 2005. Action is due in this application by December 8, 2005. Applicants are taking timely action by submitting this Amendment C and Request for Continued Application prior to December 8, 2005. 37 CFR 1.114(a)(1).

### **III. Comments Regarding Pending Claims 9-17 and 25-35**

#### **A. Amended Claim 9**

Claim 9, as amended by this paper, is directed toward a gaming apparatus operable by a player and having a slot mode and a pinball mode. The apparatus comprises:

- (a) a slot machine capable of being activated by a player in the slot mode of the apparatus to display different combinations of symbols, the symbols including a pinball symbol;
- (b) a pinball machine disposed below the symbols of the slot machine and operable in the pinball mode for the player to play a pinball game;
- (c) at least one of the combinations of symbols including the pinball symbol, the apparatus switching from the slot mode to the pinball mode upon display of said one combination by the slot machine.

Amended claim 9 is substantially the same as the previously presented claim 9 allowed by the Examiner in the Notice of Allowance. **The amended claim 9 includes all of the features of the previously presented claim 9**, and further requires that the pinball machine be disposed below the symbols of the slot machine (*see Applicants' filed application*, Figure 1). This amendment to claim 9 is submitted by Applicants with the

desire to clarify claim language and more accurately describe their invention. None of the references of record, either alone or in combination, show or suggest all of the features of amended claim 9. For this reason and for the reasons previously stated in Applicants' Amendment A ("Amendment A") dated April 14, 2005, claim 9 is submitted as patentable over the references of record.

**B. Previously Presented Claims 10-17 and 25**

Claims 10-17 and 25 have previously been presented by Applicants. Claims 10-17 were presented in Amendment A and depend either directly or indirectly from claim 9. They are submitted as patentable over the references of record, alone or in combination, for the reasons previously stated for claim 9 and for the reasons previously stated in Amendment A.

Claim 25 was presented in Applicants' Amendment B And Election Of Species ("Amendment B") dated August 10, 2005, and depends directly from claim 9. Claim 25 is submitted as patentable over the references of record, alone or in combination, for the reasons previously stated for claim 9 and for the reasons previously stated in Amendment B.

**B. New Claims 26 and 27**

Claims 26 and 27 are added by this paper and depend directly and indirectly, respectively, from claim 9. Claim 26 requires the pinball machine of the gaming apparatus have a play area oriented at an angle greater than zero degrees and less than ninety degrees above horizontal. This orientation is shown in Figures 1 and 3 of Applicants' filed application. Claim 27 requires that the pinball machine include a pinball and that the play area of the pinball machine be substantially planar. The pinball rolls over the play area of the pinball machine during operation of the pinball machine. The references of record, either alone or in combination, do not show or suggest the features of claims 26 or 27 in combination with the features of the claims from which they depend. For this reason and for the reasons stated for claim 9, claims 26 and 27 are submitted as patentable over the references of record.

### C. New Claims 28-30

New claim 28 is directed toward a gaming apparatus operable by a player and having a slot mode and a pinball mode. The apparatus comprises:

- (a) a slot machine capable of being activated by a player in the slot mode of the apparatus to display different combinations of symbols, the symbols including a pinball symbol;
- (b) a pinball machine operable in the pinball mode for the player to play a pinball game, the pinball machine including at least two flippers;
- (c) at least one of the combinations of symbols including the pinball symbol, the apparatus switching from the slot mode to the pinball mode upon display of said one combination by the slot machine.

New claim 28 is substantially similar to the previously presented claim 9 allowed by the Examiner in the Notice of Allowance. **Claim 28 includes all of the features of the previously presented claim 9**, and further requires that the pinball machine include at least two flippers (*see Applicants' filed application*, pg. 7, lns. 10-12). None of the references of record, alone or in combination, show or suggest the features of claim 28. For this reason and for the reasons previously stated in Amendment A for previously presented claim 9, claim 28 is submitted as patentable over the references of record.

New claims 29 and 30 depend from claim 28 directly and indirectly, respectively, and further describe the gaming apparatus. Claim 29 requires the pinball machine of the gaming apparatus have a play area oriented at an angle greater than zero degrees and less than ninety degrees above horizontal (*see Applicants' filed application*, Figs. 1 and 3). Claim 30 requires the pinball machine include a plunger and a pinball. The plunger moves the pinball into the play area of the pinball machine, and the pinball rolls over the play area during operation of the pinball machine. Applicants submit that the references of record, alone or in combination, do not show or suggest the features of claims 29 or 30 in combination with the features of the claims from which they depend. For this reason and for the reasons previously stated for claim 28, Applicants submit that claims 29 and 30 are patentable over the references of record.

#### **D. New Claims 31-34**

New claim 31 is directed toward a gaming apparatus operable by a player and having a slot mode and a pinball mode. The apparatus comprises:

- (a) a slot machine capable of being activated by a player in the slot mode of the apparatus to display different combinations of symbols, the symbols including a pinball symbol;
- (b) a pinball machine operable in the pinball mode for the player to play a pinball game;
- (c) the pinball machine including a play area, the play area being oriented at an angle greater than zero degrees and less than ninety degrees above horizontal;
- (d) at least one of the combinations of symbols including the pinball symbol, the apparatus switching from the slot mode to the pinball mode upon display of said one combination by the slot machine.

New claim 31 is also substantially similar to the previously presented claim 9 allowed by the Examiner in the Notice of Allowance. **Claim 31 includes all of the features of the previously presented claim 9,** and further requires that the pinball machine have a play area oriented at an angle greater than zero degrees and less than ninety degrees above horizontal (*see Applicants' filed application*, Figs. 1 and 3). None of the references of record, alone or in combination, show or suggest all of the features of claim 31. For this reason and the reasons previously stated in Amendment A for previously presented claim 9, claim 31 is submitted as patentable over the references of record.

New claims 32-34 each depend directly from claim 31 and further described the gaming apparatus. Claim 32 requires that the pinball machine include a pinball and that the play area of the pinball machine be substantially planar. The pinball rolls over the play area of the pinball machine during operation of the pinball machine. Claim 33 requires that the gaming apparatus comprise a lever that is operable by the player in the slot mode to activate the slot machine and in the pinball mode to play the pinball game. Claim 34 requires the player to be able to create a slot credit score in the slot mode of the gaming apparatus and a pinball credit score in the pinball mode of the gaming apparatus. The pinball credit score is added to the slot credit score when the pinball game ends and the gaming apparatus switches from the pinball mode to the slot mode. Applicants do not believe the features of claims 32,

33, or 34 in combination with the features of claim 31 are shown by the references of record, alone or in combination. For this reason and for the reasons previously stated for claim 31, Applicants submit that claims 32, 33, and 34 are patentable over the references of record.

**E. New Claim 35**

New claim 35 is directed toward a gaming apparatus operable by a player and having a slot mode and a pinball mode. The apparatus comprises:

- (a) a slot machine capable of being activated by a player in the slot mode of the apparatus to display different combinations of symbols and to create a slot credit score, the symbols including a pinball symbol;
- (b) a pinball machine operable in the pinball mode for the player to play a pinball game and create a pinball credit score;
- (c) at least one of the combinations of symbols including the pinball symbol, the apparatus switching from the slot mode to the pinball mode upon display of said one combination by the slot machine;
- (d) the pinball credit score being added to the slot credit score when the pinball game ends and the gaming apparatus switches from the pinball mode to the slot mode.

New claim 35 is also substantially similar to the previously presented claim 9 allowed by the Examiner in the Notice of Allowance. **Claim 35 includes all of the features of the previously presented claim 9**, and further requires that the slot machine be capable of being activated to create a slot credit score and the pinball machine be operable to create a pinball credit score. The pinball credit score is added to the slot credit score when the pinball game ends and the gaming apparatus switches from the pinball mode to the slot mode. None of the references of record, alone or in combination, show or suggest the features of claim 35, particularly the unique scoring feature (this feature was originally presented to the Examiner in dependent claim 15 in Amendment A). For this reason and the reasons previously stated in Amendment A for previously presented claim 9, claim 35 is submitted as patentable over the references of record.

#### IV. Conclusion

It is acknowledged that the Examiner has allowed all of the claims previously presented in Amendment B. Applicants thank the Examiner for his consideration. Applicants wish, however, to better describe their claimed invention and thus submit this Amendment C. It is pointed out that each of the independent claims (claims 9, 28, 31, and 35) contained in this Amendment C include every feature of previously presented claim 9 (Amendment B) allowed by the Examiner. The claims of this Amendment C do not attempt to broaden the scope of Applicants' claimed invention. Therefore, Applicants believe pending claims 9-17 and 25-35 are in allowable form and are patentable over the references of record for the reasons stated herein and for the reasons previously stated in Amendments A and B. Favorable consideration and allowance of the pending claims are respectfully requested. If the Examiner has any questions regarding this response, please contact the undersigned at the indicated phone number.

Upon entering the amendments described in this paper into the above application, the application will contain four independent claims. A payment of \$100.00 (Applicants are a small entity) is required for the excess independent claim. In addition, the filing fee for the Request for Continued Examination is \$395.00 (Applicants are a small entity). Applicants  
\* enclose a check in the amount of \$495.00 for payment of these costs and fees (*see* enclosed Fee Transmittal).

Respectfully submitted,



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\*Enclosure